

REMARKS

Claims 1-8 are pending. Claims 1-6 and 8 are rejected under 35 U.S.C. §103(a) as being obvious over Smith (U.S. Patent No. 5,900,249). Claims 1, 7, and 8 are provisionally rejected for obviousness-type double patenting over co-pending U.S. Patent Application No. 10/716,823 ("the '823 application"). Each of these rejections is addressed below.

Rejection of claims 1-6 and 8 under 35 U.S.C. §103(a)

Claims 1-6 and 8 (but not claim 7) are rejected as being obvious over Smith. According to the Examiner, "[a]bsent a clear showing of criticality, the determination of the particular ranges and concentrations are within the skill of the ordinary worker as part of the process of normal optimization." Applicants have met this rejection by amendment of claim 1, but applicants reserve the right to pursue the cancelled subject matter in this or a related application.

The Examiner acknowledges that Smith is limited to topical formulations. Accordingly, as mentioned above, applicants have overcome the obviousness rejection by amending claim 1 (the sole independent claim) so as to not read on topical formulations. As amended, claim 1 is directed to composition formulated for oral, rectal, intravenous, intramuscular, subcutaneous, inhalation, vaginal, or ophthalmic administration. In view of this amendment, applicants respectfully request that the rejection of claims 1-6, and 8 for obviousness over Smith be withdrawn.

Provisional rejection of claims 1, 7, and 8 for obviousness-type double patenting

Claims 1, 7, and 8 are provisionally rejected for obviousness-type double patenting over claims 1, 3, 5, and 7 of the '823 application. The Examiner states that the only difference between the instant claims and those in the '823 application are that the claims of the '823 application require that the claimed composition be formulated for systemic, topical, or inhalation administration. Applicants note another difference: the claims of

the '823 application recite the use of any tricyclic antidepressant, while the claims of the instant application are limited to amoxapine.

Applicants direct the Examiner's attention to MPEP 822.01, which states:

If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

In the present case, as the amendment of claim 1 has overcome the §103 rejection, the only remaining rejection is the provisional rejection for obviousness-type double patenting. In view of MPEP 822.01, applicants respectfully request that the provisional double patenting rejection issued in the instant application be withdrawn and the claims allowed to issue.


CONCLUSION

Applicants respectfully submit that the claims are now in condition for allowance, and such action is respectfully requested. If the Examiner deems that the claims are not in condition for allowance, applicants respectfully request that the Examiner telephone the undersigned to arrange for a telephonic interview to discuss any outstanding matters.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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